

WIPO



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STEPS IN THE PROCEDURE BEFORE THE
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY
IN CONNECTION WITH THE USE OF THE PCT FORMS

prepared by the International Bureau

SUMMARY

This document contains a draft outline of the steps in the procedure before the International Preliminary Examining Authority in connection with the use of the PCT Forms; it lists the tasks of the International Preliminary Examining Authority under general headings, briefly indicates steps under each task, and illustrates--in flow diagrams--such tasks and steps. The PCT Forms to be used in connection with the tasks and steps are specified in both the outline of the tasks and steps and the flow diagrams.

Background and purpose of this document

1. The PCT Interim Committee for Technical Cooperation, at its sixth session held in Geneva from November 3 to 8, 1976, placed on its program for 1977 a study of the steps in the procedure before the International Preliminary Examining Authority in connection with the use of the PCT Forms (see the report of the said session, document PCT/TCO/VI/16, paragraph 89 (iv)).
2. The primary purpose of this document is to provide reference material for the International Preliminary Examining Authority in relation to its processing of international applications under the PCT. This reference material may be regarded as complementary to the Guidelines for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty (PCT) (see document PCT/TCO/VII/6), since it indicates to the International Preliminary Examining Authority the PCT Form that is appropriate in particular situations dealt with in those Guidelines. Having regard to the fact that a consideration of procedural matters involving the use of the PCT Forms is also of interest to the Interim Advisory Committee for Administrative Questions, consideration of the present document has been placed on the agendas of both that Committee and the Interim Committee for Technical Cooperation (the two Committees are hereinafter referred to as "the Interim Committees") for their consideration in a joint meeting.
3. To facilitate the presentation of the said reference material, the processing of international applications by the International Preliminary Examining Authority has been arranged according to "procedural tasks" each comprising a number of "procedural steps." The sequence of tasks and steps set forth in this document has also only been used for reasons of presentation and should not be taken as suggesting that it is necessary to complete any particular task or step before undertaking another task or step.

The Annex to this document

4. The Annex deals with the processing of international applications by the International Preliminary Examining Authority ("IPEA"). The Annex is subdivided into three parts: the first (Part A) indicating the procedural tasks; the second (Part B) describing the various steps under each task; and the third (Part C) consisting of flow diagrams illustrating the tasks, the steps and the PCT Forms to be used.

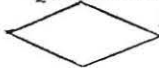
The procedural tasks

5. The procedural tasks referred to in Parts A, B and C are indicated by the symbol of the Authority ("IPEA"), an oblique stroke and a number. For example, "IPEA/4" means task number 4 of the International Preliminary Examining Authority.



The processing steps

6. The processing steps are described and annotated with references to the relevant provisions of the Articles of the PCT and the Rules and Administrative Instructions thereunder and, where applicable, with references to the PCT Forms. These steps are indicated by the symbol of the Authority followed by an oblique stroke, the number of the task and, after a decimal point, by the number of the step. For example: "IPEA/4.3" means step number 3 of the task number 4 of the International Preliminary Examining Authority.

The flow diagrams

7. The flow diagrams are contained in charts. Each chart has a double line running along the right-hand side of the page. This double line traces the normal flow of the processing of an international application. The procedural tasks indicated along this "normal flow line" are, whenever possible, set forth in chronological sequence. Questions presented in the flow of processing are represented by the figure  in which key words are included.

8. The arrangement of the normal processing flow is such that, for the vast majority of international applications, vis-à-vis the questions presented along the normal flow line under any particular procedural task, the answer will be negative (indicated by the letter "N" (for "no")) and the processing proceeds down the normal flow line rather than encounter the abnormal processing occurring when an affirmative answer (indicated by the letter "Y" (for "yes")) diverts the processing temporarily, or, in some situations, permanently, from continuing down the normal flow line.

9. Processing steps to be taken are represented by the figure  in which the key words are included and, as the purpose of this document is to explain the use of the PCT Forms, any communication arising from any given processing step and requiring the use of any given Form is indicated by the figure  - - - - and above that figure, the symbol of the Form to be used (for example: PCT/IPEA/421). The contents of the Form to be used can be readily ascertained by reference to document PCT/INT/2, Annex F, containing the Forms under the PCT Administrative Instructions.

10. The Forms are identified in the manner used in document PCT/INT/2. Such identification consists of the symbol PCT, an oblique stroke, the symbol of the International Preliminary Examining Authority, an oblique stroke, and the number of the Form (for example: "PCT/IPEA/421").

11. The Interim Committees are invited to consider the annexed outline of procedural tasks, processing steps and flow diagrams with particular reference to the use of the PCT Forms and to provide their advice to the International Bureau.

[Annex follows]

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[Part A follows]

PART A INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY: PROCEDURAL TASKS

TASK SYMBOL	TASK
IPEA/1	RECEIPT OF THE DEMAND
IPEA/2	RULE 54 CHECK (APPLICANT(S) ENTITLED TO MAKE A DEMAND)
IPEA/3	RULE 60.1 CHECK (DEFECTS IN THE DEMAND)
IPEA/4	RULE 57 CHECK (PAYMENT OF HANDLING FEE)
IPEA/5	RULE 61.1 TRANSMITTAL AND NOTIFICATION OF DEMAND
IPEA/6	RULE 55.2 CHECK (TRANSLATION OF INTERNATIONAL APPLICATION)
IPEA/7	RULE 66.7 PRIORITY DOCUMENT AND TRANSLATION
IPEA/8	RULE 62.2(a) AND 66.1 AMENDMENTS
IPEA/9	RULE 66.2 FIRST WRITTEN OPINION
IPEA/10	ARTICLE 34(3) CHECK (LACK OF COMPLIANCE WITH REQUIREMENT OF UNITY OF INVENTION)
IPEA/11	ARTICLE 34(4) CHECK (EXAMINATION REQUIRED AND POSSIBLE)
IPEA/12	RULE 91 CHECK (RECTIFICATION OF OBVIOUS ERRORS OF TRANSCRIPTION)
IPEA/13	RULE 83 REQUEST FOR PROOF OF RIGHT TO PRACTICE
IPEA/14	ARTICLE 35 ESTABLISHMENT OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT
IPEA/15	RULE 71 TRANSMITTAL OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT
IPEA/16	RULE 71.2 PREPARATION AND TRANSMITTAL OF COPIES OF CITED DOCUMENTS
IPEA/17	RULE 93.3 KEEPING OF RECORDS AND FILES
IPEA/18	RULE 94 FURNISHING OF COPIES
IPEA/19	RULE 92 NEED FOR SIGNATURE WITH REGARD TO CORRESPONDENCE

[Part B follows]

PART B INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY: ANNOTATED DESCRIPTION OF THE STEPS UNDER THE PROCEDURAL TASKS

IPEA/1 RECEIPT OF THE DEMAND

IPEA/1.0 The International Preliminary Examining Authority receives copies of the demand (Form PCT/IPEA/401) submitted by the applicant (Article 31(6)(a)).

IPEA/2 RULE 54 CHECK (APPLICANT(S) ENTITLED TO MAKE A DEMAND)

IPEA/2.0 The International Preliminary Examining Authority finds that the applicant (or applicants) is (are) entitled to make a demand (Article 31(2), Rule 54.2) or that, in the case of different applicants for different elected States, no applicant entitled to make a demand (Rule 54.3) is indicated for the purposes of a given elected State or given elected States.

IPEA/2.1 The International Preliminary Examining Authority notifies (Form PCT/IPEA/418), the applicant (or applicants) and the International Bureau that it has determined that the right to make a demand for international preliminary examination does not exist (Section 601(a) of the Administrative Instructions).

IPEA/2.2 The International Preliminary Examining Authority notifies (Form PCT/IPEA/419) the applicant (or applicants) that he (or they) is (are) not entitled to elect a given elected State (or given but not all elected States) (Section 601(b) of the Administrative Instructions).

IPEA/3 RULE 60.1 CHECK (DEFECTS IN THE DEMAND)

IPEA/3.0 The International Preliminary Examining Authority finds defects existing in the demand (Rule 60.1(a)).

IPEA/3.1 The International Preliminary Examining Authority invites (Form PCT/IPEA/404) the applicant to correct the defects within the prescribed time limit (within one month from the date of the invitation) (Rule 60.1(a)).

IPEA/3.2 The International Preliminary Examining Authority finds that the applicant has not timely filed corrections to the demand.

IPEA/3.3 The International Preliminary Examining Authority notifies (item 3 of Form PCT/IPEA/407) the applicant and the International Bureau that the demand is considered as if it had not been submitted (Rule 60.1(c)).

IPEA/4 RULE 57 CHECK (PAYMENT OF HANDLING FEE)

IPEA/4.0 The International Preliminary Examining Authority finds that payment of the required amount of the handling fee is lacking at the time of submission of the demand (Rule 57.3(a)).

IPEA/4.1 The International Preliminary Examining Authority invites (Form PCT/IPEA/403) the applicant to submit payment of the required amount within the prescribed time limit (within one month from the date of the invitation) (Rule 57.4(a)).

IPEA/4.2 The International Preliminary Examining Authority finds that the required amount has not been timely paid.

IPEA/4.3 The International Preliminary Examining Authority notifies (item 2 of Form PCT/IPEA/407) the applicant and the International Bureau that, in respect of the non-payment of the handling fee, the demand is considered as if it had not been submitted (Rule 57.4(c)).

IPEA/5 RULE 61.1 TRANSMITTAL AND NOTIFICATION OF DEMAND

IPEA/5.0 The International Preliminary Examining Authority indicates in the demand the date of receipt and sends (item 1 of Form PCT/IPEA/415) the original copy of the demand to the International Bureau (keeping the other copy in its files) and notifies (Form PCT/IPEA/402) the applicant of the date of receipt of the demand. This date may be the actual date of receipt or the date of receipt of timely payment of the handling fee or the date of receipt of timely corrections of the defects in the demand (Rules 61.1(a), (b), 57.4(b) and 60.1(b)).

IPEA/6 RULE 55.2 CHECK (TRANSLATION OF INTERNATIONAL APPLICATION)

IPEA/6.0 The International Preliminary Examining Authority checks whether the applicant has timely submitted (Rule 55.2(b) a translation (if required by the International Preliminary Examining Authority) of the international application containing a signed statement by him that, to the best of his knowledge, the translation is complete and faithful (Rule 55.2(a) and (c)).

IPEA/6.1 The International Preliminary Examining Authority finds that the translation and/or the applicant's signed statement is lacking and invites (Form PCT/IPEA/406) the applicant to submit the required translation of the international application and/or signed statement within the prescribed time limit (within one month from the date of the invitation) (Rule 55.2(d)).

IPEA/6.2 The International Preliminary Examining Authority finds that the translation and signed statement have not been timely filed.

IPEA/6.3 The International Preliminary Examining Authority notifies the applicant and the International Bureau (item 1 of Form PCT/IPEA/407) that the demand shall be considered as if it had not been submitted (Rule 55.2(d)).

IPEA/7 RULE 66.7 (PRIORITY DOCUMENT AND TRANSLATION)

IPEA/7.0 The International Preliminary Examining Authority needs the priority documents or a translation of the priority documents.

IPEA/7.1 The International Preliminary Examining Authority requests (item 1 of Form PCT/IPEA/414) the International Bureau to furnish a copy of the priority document or requests the applicant, where a certified copy of the priority document has not yet been submitted to the International Bureau in accordance with Rule 17.1(a), to furnish a certified copy of the priority document and, where required, invites (item 2 of Form PCT/IPEA/414) the applicant to furnish a translation thereof within the prescribed time limit (not later than by the expiration of two months from the date of the request or the invitation to the applicant (Rule 66.7)).

IPEA/7.2 The International Preliminary Examining Authority finds that the requested priority document and (where required) the translation have not been timely furnished (Rule 66.7(c)).

IPEA/7.3 The International Preliminary Examining Authority indicates in the international preliminary examination report (item 2(b) of Form PCT/IPEA/409) that the report was established as if the priority had not been claimed (Rule 66.7(c)).

IPEA/8 RULE 62.2(a) AND 66.1 AMENDMENTS

IPEA/8.0 The International Preliminary Examining Authority finds that the applicant has submitted amendments (in the form of replacement sheets (Rule 46.5)) to the claims (Rule 62.2(a)) or to the claims, the description and the drawings before the start of the international preliminary examination (Rule 66.1).

- IPEA/8.1 The International Preliminary Examining Authority marks on each replacement sheet the international application number, the date on which it was received and the stamp of the International Preliminary Examining Authority and commences international preliminary examination on the international application as amended (Rules 66.8(b) and 66.1).
- IPEA/9 RULE 66.2 FIRST WRITTEN OPINION
- IPEA/9.0 The International Preliminary Examining Authority considers whether any of the matters mentioned in Rule 66.2(a)(i) to (v) is applicable.
- IPEA/9.1 The International Preliminary Examining Authority issues (Form PCT/IPEA/408) a first written opinion. Additional written opinions may be issued (Rules 66.2 and 66.4).
- IPEA/10 ARTICLE 34(3) CHECK (LACK OF COMPLIANCE WITH REQUIREMENT OF UNITY OF INVENTION)
- IPEA/10.0 The International Preliminary Examining Authority finds that the international application lacks compliance with the requirement of unity of invention.
- IPEA/10.1 The International Preliminary Examining Authority chooses to invite the applicant to restrict the claims or to pay additional fees.
- IPEA/10.2 The International Preliminary Examining Authority invites (Form PCT/IPEA/405) applicant, at his option, to restrict the claims or to pay additional fees (Rule 68.2) within a time limit fixed by the International Preliminary Examining Authority in the invitation (not shorter than one month, and not longer than 2 months from the date of the invitation to restrict or pay (Rule 68.2)) with regard to the circumstances of the case.
- IPEA/10.3 The International Preliminary Examining Authority establishes the international preliminary examination report on the entire international application with indication in the international preliminary examination report (item 3 of Form PCT/IPEA/409), that, in its opinion, the requirement of unity of invention is not fulfilled and the reasons therefor (Rule 68.1).
- IPEA/10.4 The International Preliminary Examining Authority finds that the applicant did not timely comply with the invitation to restrict or pay additional fees.
- IPEA/10.5 The International Preliminary Examining Authority establishes the international preliminary examination report (item 3 of Form PCT/IPEA/409) on the main invention (Article 34(3)(c)).
- IPEA/10.6 The International Preliminary Examining Authority finds that additional fees were paid under protest (Rule 68.3(c)).
- IPEA/10.7 The International Preliminary Examining Authority, by means of a three member board or other special instance of that Authority (or any competent higher authority), examines the applicant's protest and decides on the justification of the protest and notifies (Form PCT/IPEA/420) the applicant accordingly (Rule 68.3(c), Section 603 of the Administrative Instructions).
- IPEA/10.8 The International Preliminary Examining Authority registers the notice of protest and the decision thereon and, if requested by the applicant to notify them to the elected Offices, forwards them together with the international preliminary examination report (item 3(a) of Form PCT/IPEA/409) to the International Bureau (Rule 68.3(c)).
- IPEA/10.9 The International Preliminary Examining Authority examines the inventions for which additional fees have been paid or the invention to which restriction has been made.

IPEA/11 Article 34(4) CHECK (EXAMINATION REQUIRED AND POSSIBLE)

- IPEA/11.0 The International Preliminary Examining Authority checks whether Article 34(4) (a) applies to the international application.
- IPEA/11.1 The International Preliminary Examining Authority finds that all of the claims of the international application are affected (Article 34(4) (a)).
- IPEA/11.2 The International Preliminary Examining Authority notifies (Form PCT/IPEA/408) the applicant that in respect of all the claims of the international application it will not go into the questions referred to in Article 33(1), i.e., whether the claimed invention appears to be novel, involves an inventive step (non-obviousness), and is industrially applicable (Article 34(4) (a)).
- IPEA/11.3 The International Preliminary Examining Authority notifies (Form PCT/IPEA/408) the applicant that in respect of certain of the claims of the international application it will not go into the questions referred to in Article 33(1), i.e., whether the claimed invention appears to be novel, involves an inventive step (non-obviousness), and is industrially applicable (Article 34(4) (b)).
- IPEA/11.4 The International Preliminary Examining Authority indicates in the international preliminary examination report (item 4 of Form PCT/IPEA/409) those claims in respect of which the questions referred to in Article 33(1) have not been gone into.

IPEA/12 RULE 91 CHECK (RECTIFICATION OF OBVIOUS ERRORS OF TRANSCRIPTION)

- IPEA/12.0 The International Preliminary Examining Authority notes obvious errors of transcription (Rule 91.1(d)).
- IPEA/12.1 The International Preliminary Examining Authority invites (Form PCT/IPEA/411) the applicant to submit a request for rectification of obvious errors of transcription (Rule 91.1(d)).
- IPEA/12.2 The International Preliminary Examining Authority finds, where it is presented with a request for rectification by the applicant, that the rectification requested is of an obvious error (Rule 91.1(b) and (c)) and that the request for rectification was timely filed, i.e., filed within a time permitting timely authorization of the rectification by the International Preliminary Examining Authority.
- IPEA/12.3 The International Preliminary Examining Authority timely authorizes (until establishment of the international preliminary examination report (Rule 91.1(g) (iii)) rectification (Rule 91.1(e) (iii)) and records the date of authorization for rectification in the files of the international application (Rule 91.1(f)).
- IPEA/12.4 The International Preliminary Examining Authority notifies (Form PCT/IPEA/412) the applicant and the International Bureau of the authorization for rectification or, where the authorization for rectification was denied, notifies (Form PCT/IPEA/412) only the applicant (Rule 91.1(h), Section 109 of the Administrative Instructions).

IPEA/13 RULE 83 REQUEST FOR PROOF OF RIGHT TO PRACTICE

- IPEA/13.0 The International Preliminary Examining Authority decides that, with respect to any particular international application, proof that the interested person is entitled to practice under Article 49 is needed (Rule 83.1).
- IPEA/13.1 The International Preliminary Examining Authority requests (Form PCT/IPEA/410) the receiving Office to produce proof of the right to practice (Rule 83.2(a)).

IPEA/14 ARTICLE 35 ESTABLISHMENT OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT

IPEA/14.0 The International Preliminary Examining Authority establishes the international preliminary examination report (Form PCT/IPEA/409) (Rule 70).

IPEA/15 RULE 71 TRANSMITTAL OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT

IPEA/15.0 The International Preliminary Examining Authority on the same day, transmits copies of the international preliminary examination report (Form PCT/IPEA/409) and its annexes, if any, to the International Bureau (item 2 of Form PCT/IPEA/415) and the applicant (Form PCT/IPEA/416) (Rule 71.1).

IPEA/16 RULE 71.3 PREPARATION AND TRANSMITTAL OF COPIES OF CITED DOCUMENTS

IPEA/16.0 The International Preliminary Examining Authority receives a timely request (within 7 years from the international filing date (Rule 71.2(a)) from the applicant and/or from the elected Offices for copies of the documents cited in the international preliminary examination report and which were not cited in the international search report (Article 36(4)).

IPEA/16.1 The International Preliminary Examining Authority opts for the International Bureau to furnish copies of the documents requested (Rule 71.2(c)).

IPEA/16.2 The International Preliminary Examining Authority forwards (item 3 of Form PCT/IPEA/415) a copy of the documents to the International Bureau for transmittal (Rule 71.2(c)).

IPEA/16.3 The International Preliminary Examining Authority, subject to reimbursement of cost (Form PCT/IPEA/421) forwards (Form PCT/IPEA/417) copies of requested documents to the applicant and to the elected Offices (Rule 71.2(b)).

IPEA/17 RULE 93.3 KEEPING OF RECORDS AND FILES

IPEA/17.0 The International Preliminary Examining Authority shall keep the file of each international application for at least ten years from the international filing date (Rule 93.3).

IPEA/18 RULE 94 FURNISHING OF COPIES

IPEA/18.0 The International Preliminary Examining Authority receives a request for a copy of any document in the file of an international application from the applicant or any person authorized by the applicant (Rule 94.1).

IPEA/18.1 The International Preliminary Examining Authority prepares and transmits (Form PCT/IPEA/413, subject to reimbursement of cost (Form PCT/IPEA/422), copies of documents in the file of the international application (Rule 94.1).

IPEA/19 RULE 92 NEED FOR SIGNATURE WITH REGARD TO CORRESPONDENCE

IPEA/19.0 The International Preliminary Examining Authority finds that in the case of papers in the form of a letter received from the applicant or papers accompanied by a letter identifying the international application, the papers and/or letter were unsigned (Rule 92.1(a)).

IPEA/19.1 The International Preliminary Examining Authority finds that, in respect of lack of compliance of the applicant to properly sign the papers, the papers are considered not to have been submitted (Rule 92.1(b)).

- IPEA/19.2 The International Preliminary Examining Authority notifies (Form PCT/IPEA/423) the applicant of his lack of signature by returning the papers for his signature and resubmission.
- IPEA/19.3 The International Preliminary Examining Authority finds that the applicant has returned the papers properly signed.

[Part C follows]

PART/C INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY:
FLOW DIAGRAMS

IPEA/1 Receipt of the Demand

IPEA/2 Rule 54 Check (Applicant Entitled to Make a Demand)

PCT/IPEA/418 IPEA/2.1
No entitlement
to make
demand

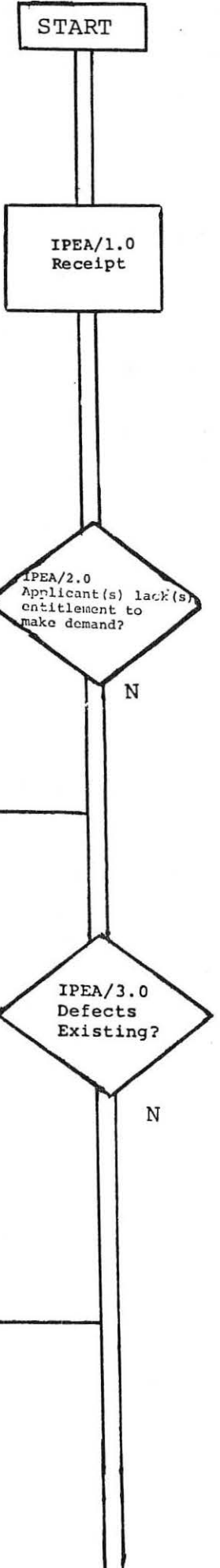
PCT/IPEA/419 or PCT/IPEA/419 IPEA/2.2
No entitlement
to elect
State(s)

IPEA/3 Rule 60.1 Check (Defects in the Demand)

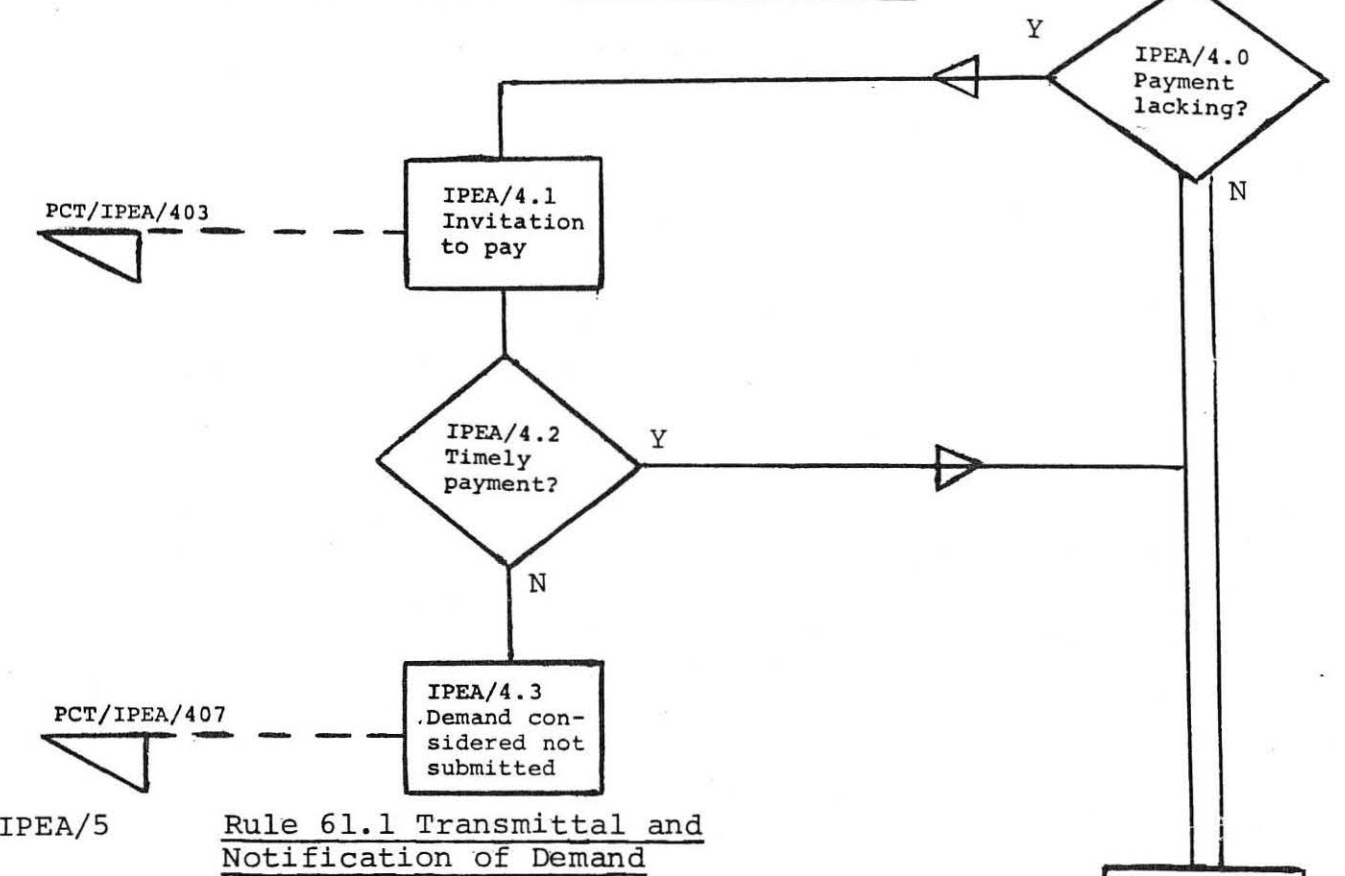
PCT/IPEA/404 IPEA/3.1
Invitation
to correct

IPEA/3.2
Timely
correction?

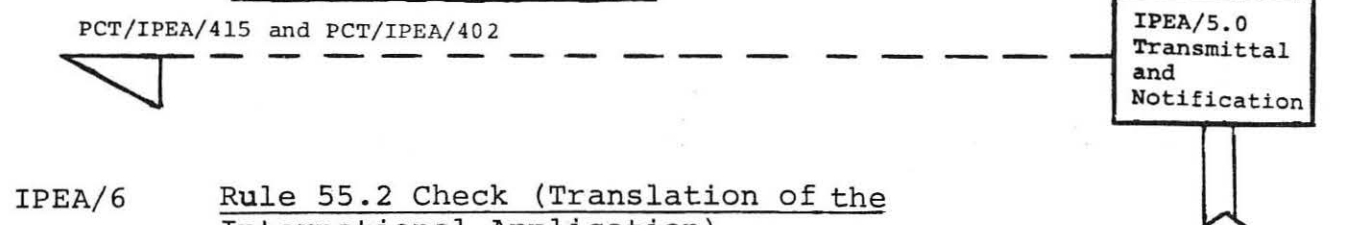
PCT/IPEA/407 IPEA/3.3
Demand con-
sidered not
submitted



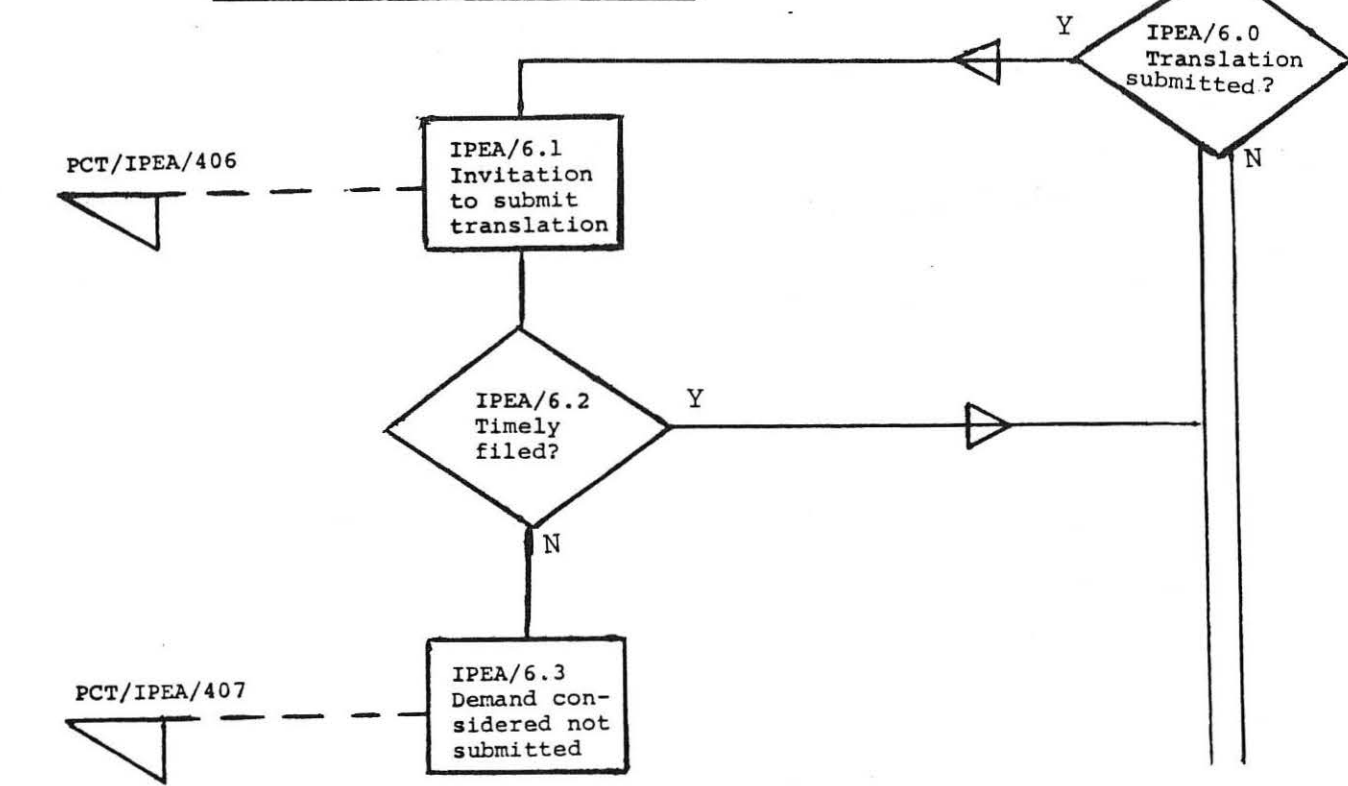
IPEA/4 Rule 57 Check (Payment of Handling Fee)



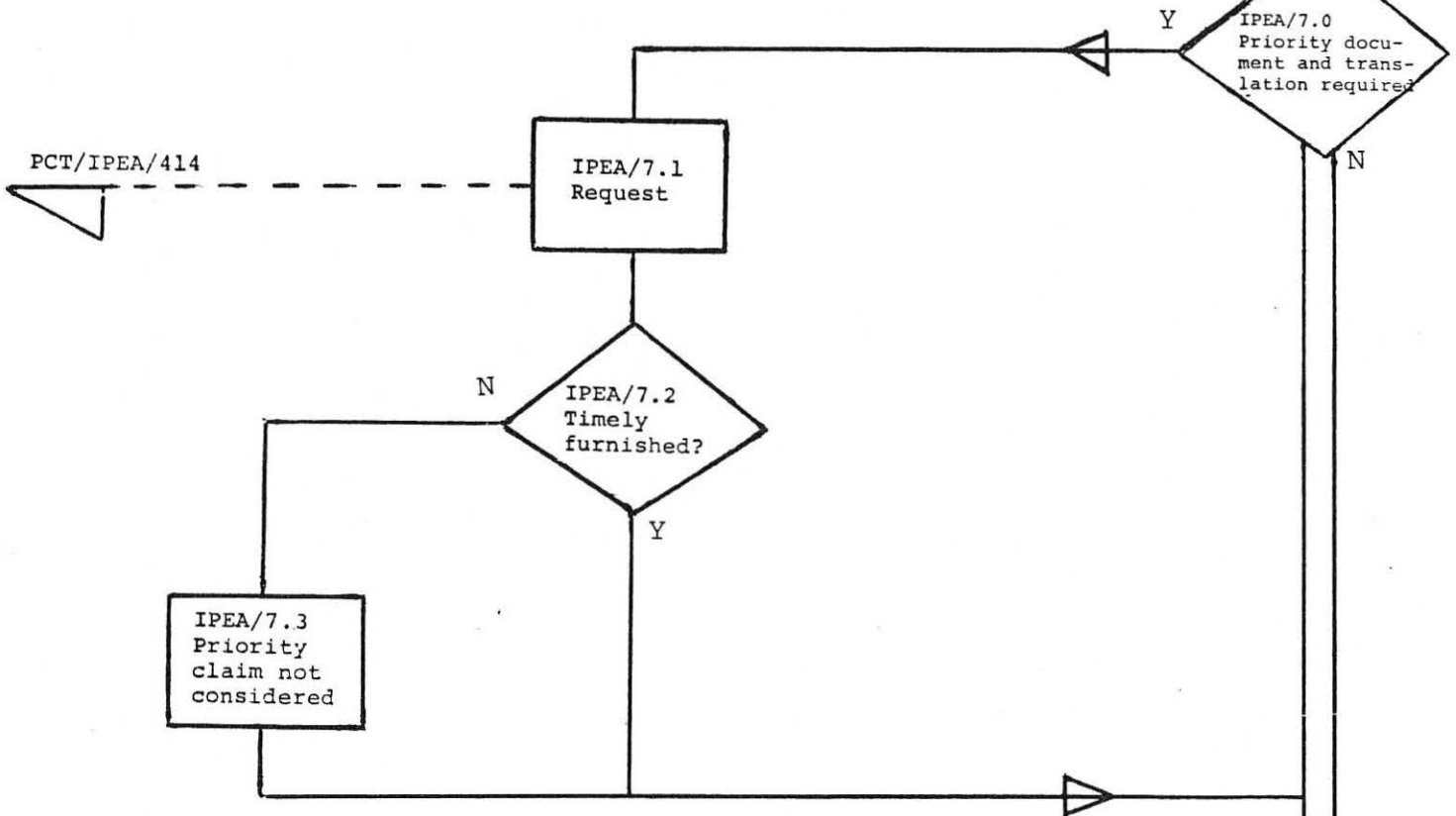
IPEA/5 Rule 61.1 Transmittal and Notification of Demand



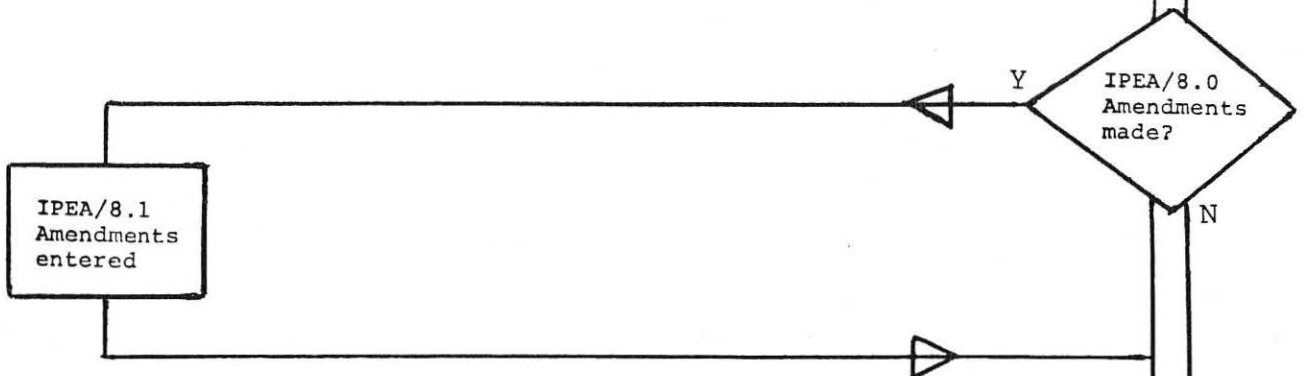
IPEA/6 Rule 55.2 Check (Translation of the International Application)



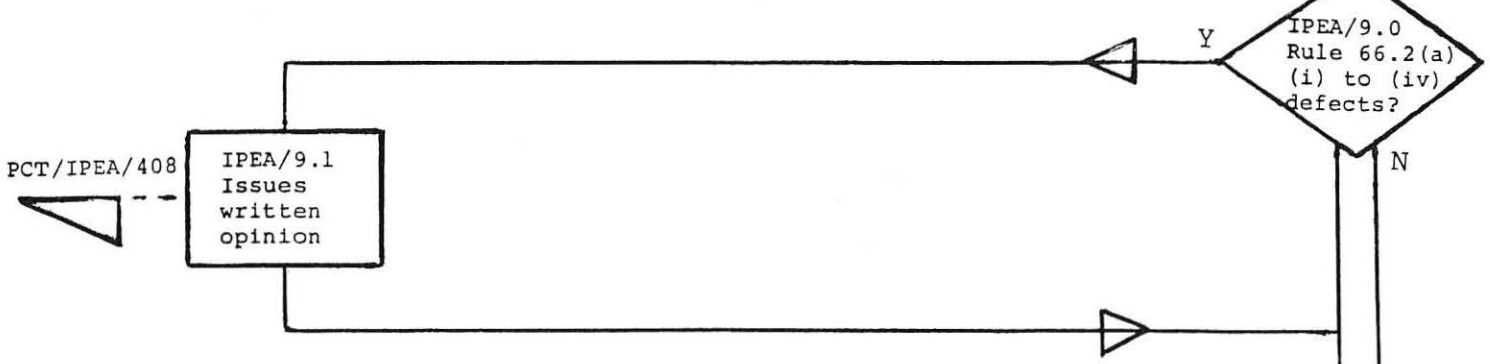
IPEA/7 Rule 66.7 Priority Document and Translation



IPEA/8 Rule 62.2(a) and 66.1 Amendments

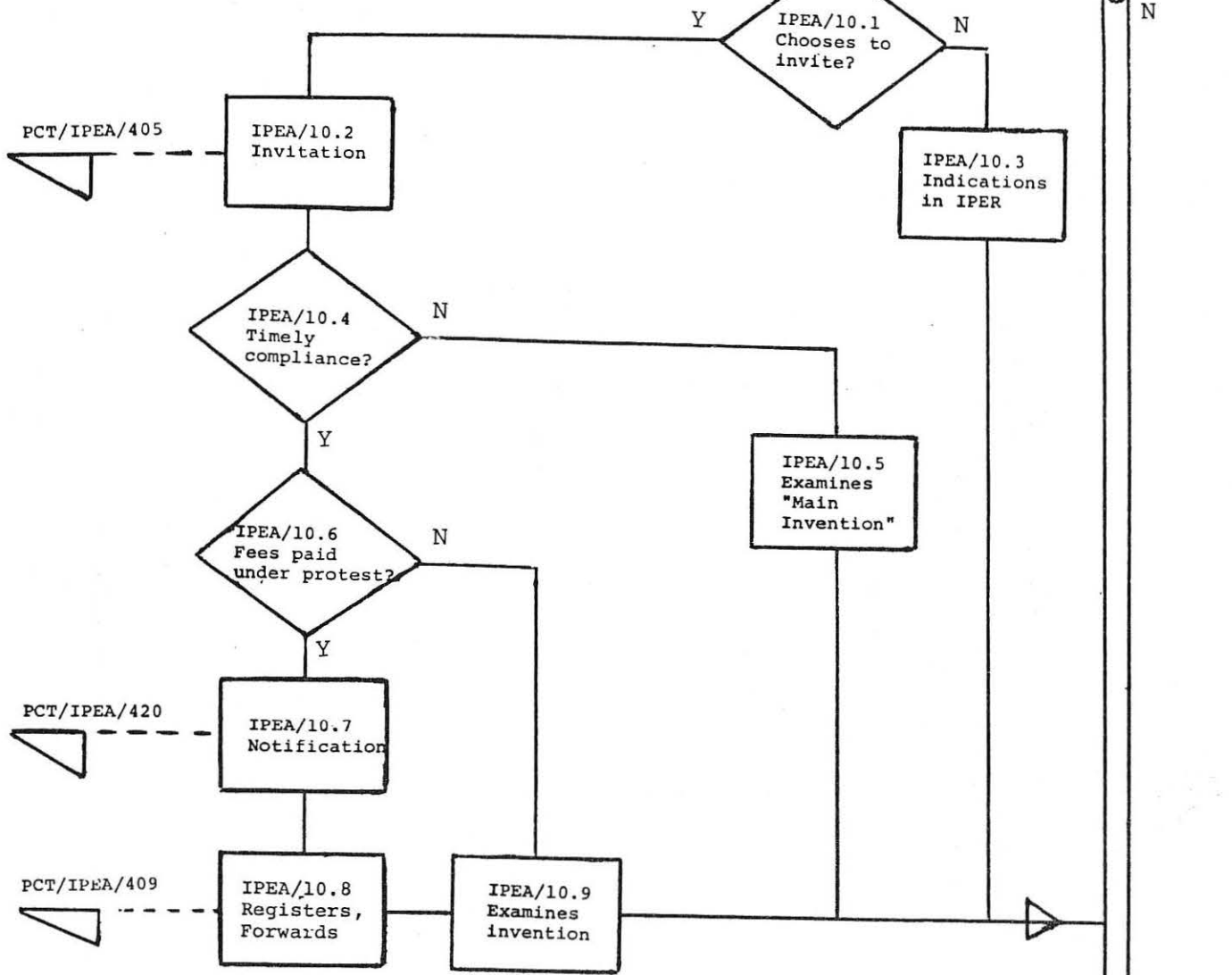


IPEA/9 Rule 66.2 First Written Opinion



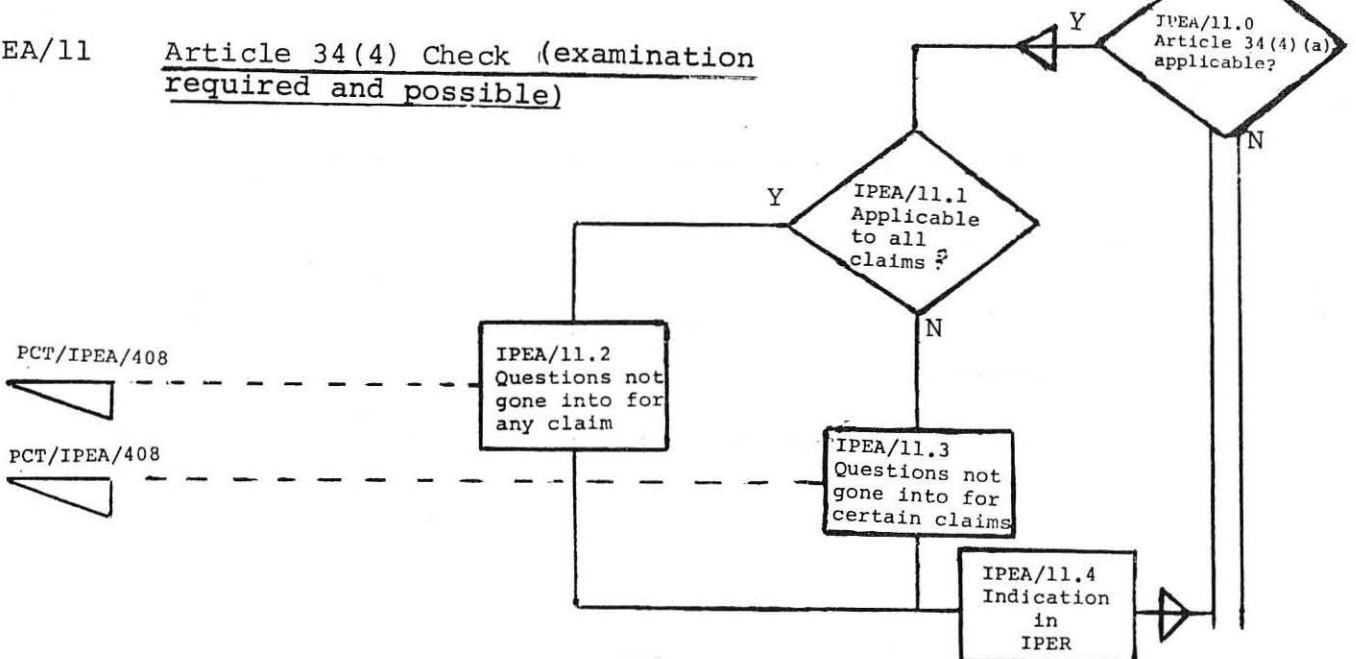
IPEA/10

Article 34(3) Check (lack of compliance with requirement of unity of invention)



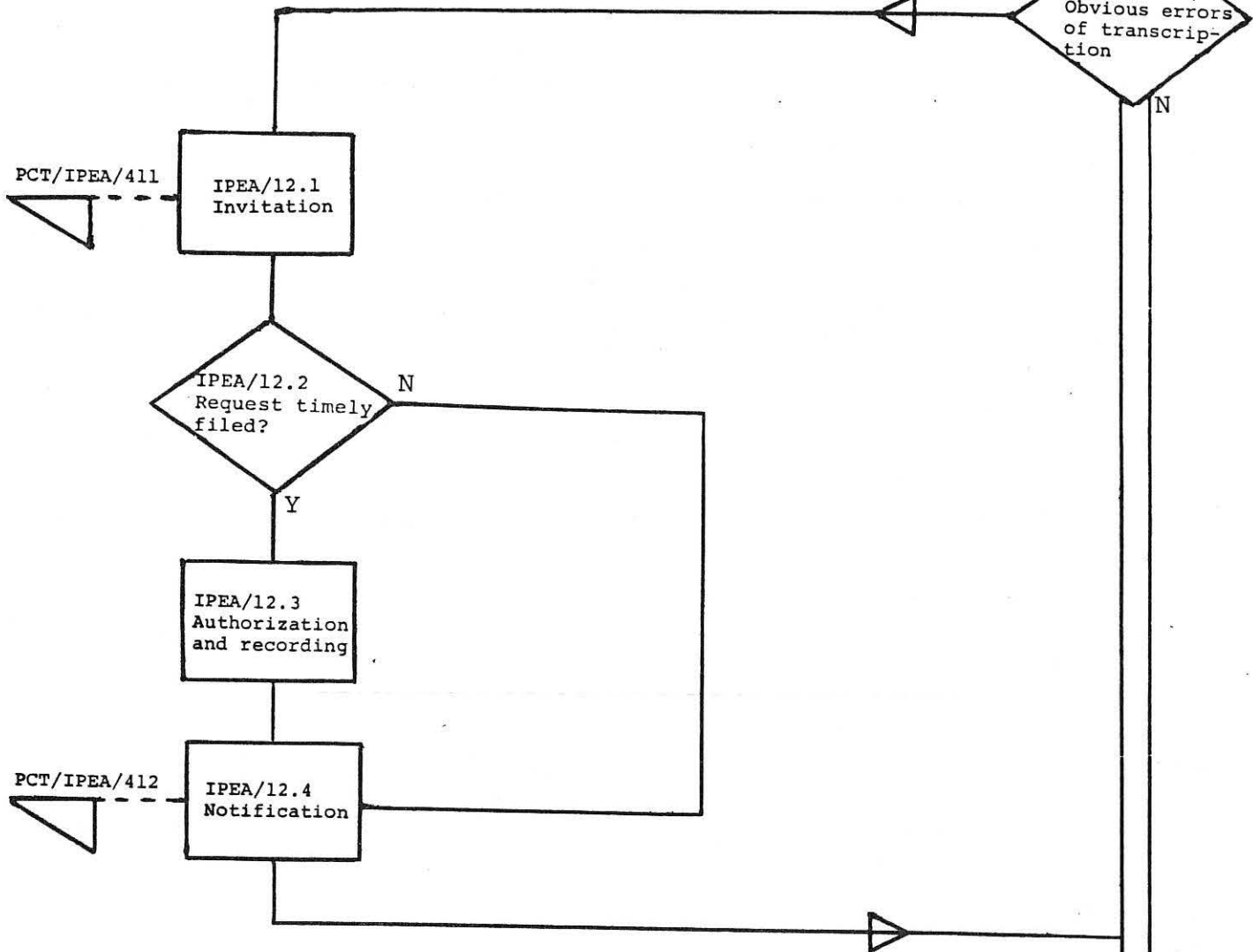
IPEA/11

Article 34(4) Check (examination required and possible)



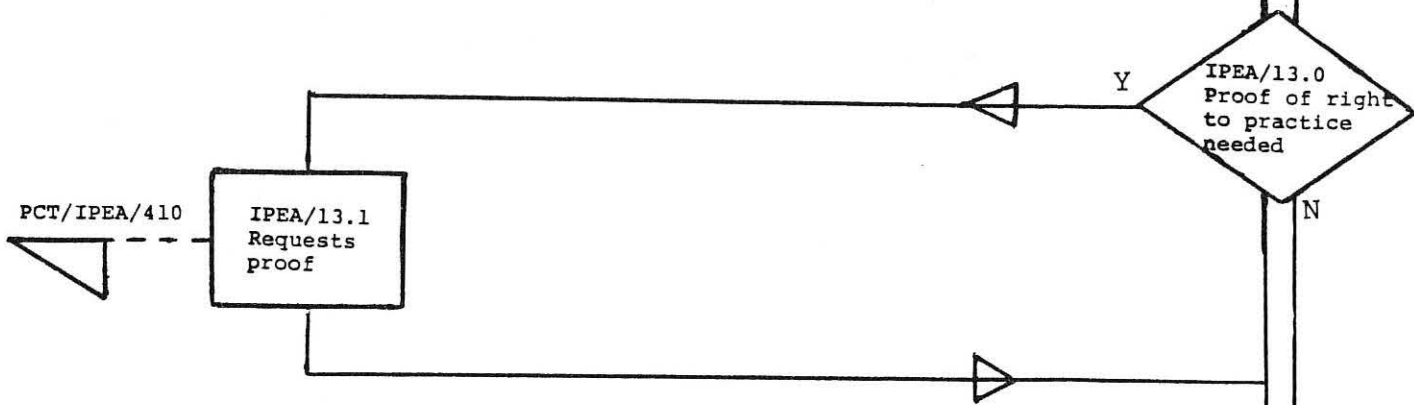
IPEA/12

Rule 91 Check (rectification of obvious errors of transcription)



IPEA/13

Rule 83 Request for Proof of Right to Practice



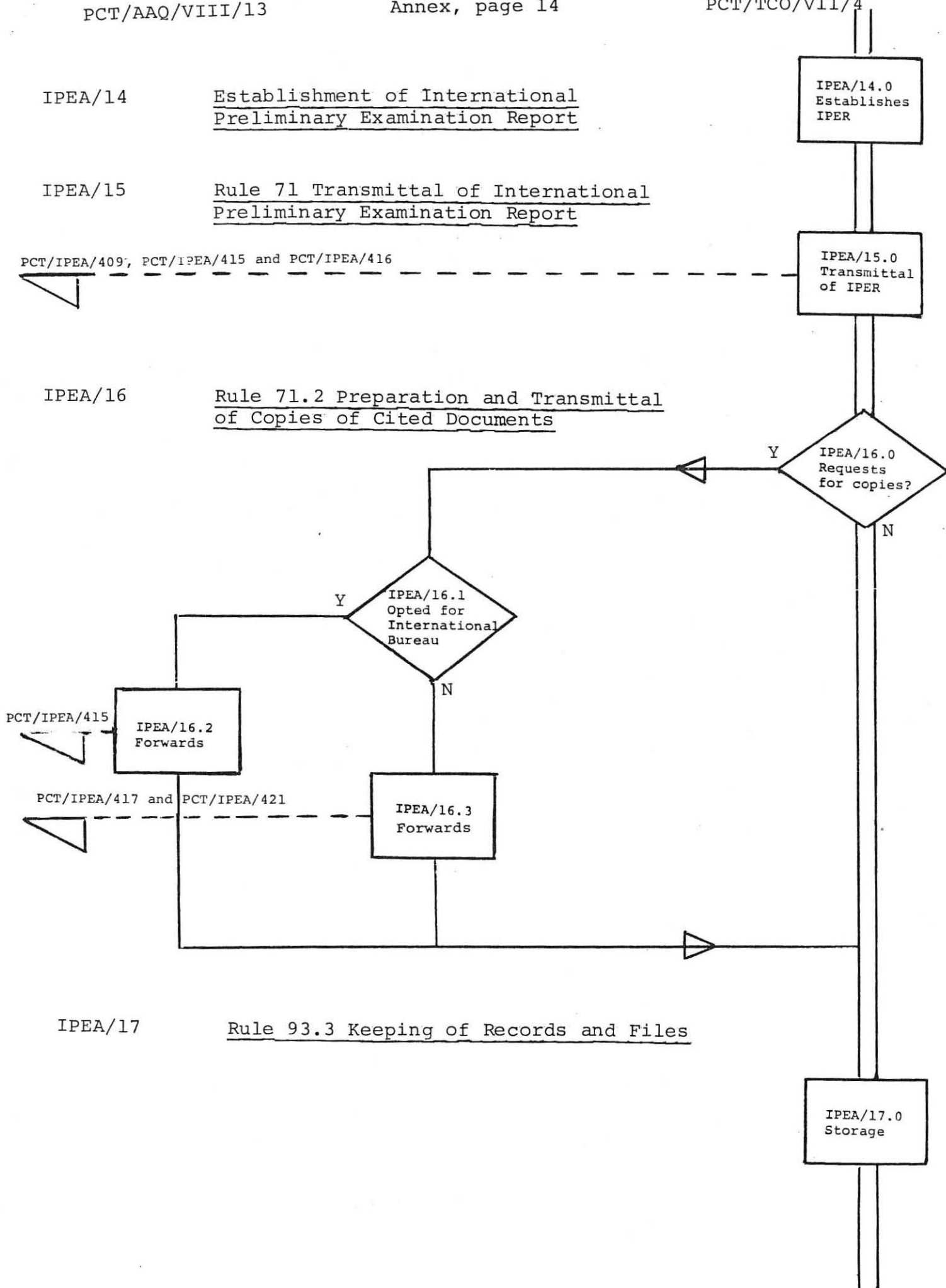
IPEA/14 Establishment of International Preliminary Examination Report

IPEA/15 Rule 71 Transmittal of International Preliminary Examination Report

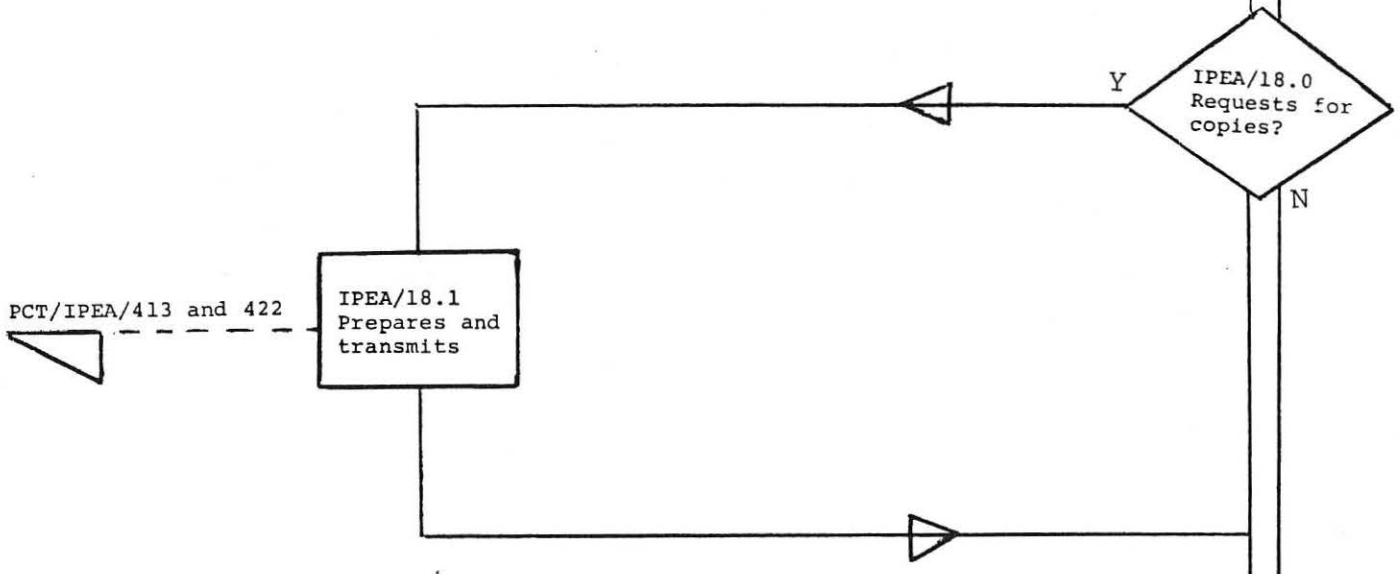
PCT/IPEA/409, PCT/IPEA/415 and PCT/IPEA/416

IPEA/16 Rule 71.2 Preparation and Transmittal of Copies of Cited Documents

IPEA/17 Rule 93.3 Keeping of Records and Files



IPEA/18 Rule 94 Furnishing of Copies



IPEA/19 Rule 92 Need for Signature with regard to Correspondence

